IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of John R. Hind, et al.　　　　　　　　　August 17, 2006

Serial Nbr:　　09/973,883

Filed:　　　　October 10, 2001

For:　　　　Adaptive Indexing Technique for Use with Electronic Objects

Art Unit:　　2166

Examiner:　　Isaac M. Woo

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

　　　This is an Appeal seeking reversal of the decision of the Primary Examiner, finally

rejecting Claims 1 - 5, 7 - 8, and 10 - 19 of the subject patent application.

1) REAL PARTY IN INTEREST

The real party in interest is the Assignee, International Business Machines Corporation ("IBM").

2) RELATED APPEALS AND INTERFERENCES

Appellants, the Appellants' legal representative, and the assignee, have no personal knowledge of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3) STATUS OF CLAIMS

Claims 1 - 5, 7 - 8, and 10 - 19 stand rejected. Claims 9 and 20 have been cancelled from the application without prejudice. Claim 6 is objected to as being dependent upon a rejected base claim. Claims 1 - 5, 7 - 8, and 10 - 19 are under appeal.

4) STATUS OF AMENDMENTS

An Amendment was filed on April 12, 2006 after receiving the Final Rejection mailed on February 13, 2006. The Amendment has <u>not</u> been entered.

5) SUMMARY OF CLAIMED SUBJECT MATTER

1.   Appellants' independent Claim 1 specifies a computer-implemented method for indicating criteria for organizing electronic objects, comprising elements of "detecting, by a user input monitor, that a user has <u>swiped across</u> an element of a rendered representation of an electronic object" (Claim 1, lines 3 - 4, emphasis added); "comparing <u>a manner in which the swiping was</u>

performed, responsive to the detecting, to previously-defined settings that specify what manner of swiping indicates an identification of dynamically-identified, user-defined organizing criteria" (Claim 1, lines 5 - 7, emphasis added); and "storing, if the comparing step determines that the manner in which the swiping was performed is consistent with the specified settings, the swiped-across element in a repository of criteria, from which the stored element can subsequently be selected for inclusion in a pattern to be matched against electronic objects for programmatically organizing the electronic objects" (Claim 1, lines 8 - 11, emphasis added).

2.   In other words, the user performs a "swiping" action across a rendered representation in some "manner" (Specification, p. 35, lines 12 - 15), and if this manner is consistent with previously-defined settings for swiping (Specification, p. 37, lines 7 - 16), then the user has thereby indicated that the swiped-across element is to be subsequently usable in pattern matching for organizing electronic objects (Specification, p. 35, line 12 - p. 36, line 8; p. 37, lines 19 - 20; see also p. 11, lines 2 - 3, referring to this "innovative selection" technique for indicating "criteria which may be used for organizing stored objects", and p. 39, lines 8 - 9, referring to an "adaptive index" that may be created using the criteria obtained in this dynamic manner). For example, a user may pass a mouse pointer repeatedly across words that are rendered on a display screen, and if the manner in which he passes the mouse pointer repeatedly across the words is consistent with previously-defined settings, then the words will be stored in the repository of criteria and can subsequently be selected for inclusion in a pattern. (Specification, p. 35, line 12 - p. 36, line 8; see also **Figs. 10A** and **10B**, where a "hand" symbol **1010** is shown to represent the user swiping across words at **1005**, **1015** of **Fig. 10A** and across part of an image at **1020** in **Fig. 10B**.) The

pattern may then be matched against objects to organize those objects; for example, if the pattern is a portion of an image, the organizing operation that uses this pattern can <u>select all compared-to images</u> that <u>include</u> this pattern/portion. (Specification, p. 26, lines 1, 8 - 9, 13 - 15. See also Specification, p. 26, line 16 - p. 27, line 19, which discusses in some detail the organizing of image objects; the swiped portion is referred to therein as a "representative bitmap". Use of a stored bitmap when building a pattern-matching rule is discussed at p. 29, lines 13 - 15; in this example, the bitmap comprises a miniature logo.)

3.   Independent Claims 18 and 19 specify similar limitations to those of independent Claim 1, and further specify "enabling the stored element to be <u>subsequently selected as an organizing criterion</u> for use in a rule, wherein the rule can subsequently be used for programmatically organizing the electronic objects" (Claim 18, lines 12 - 14, emphasis added).

4.   Dependent Claim 2 specifies that the user can configure the defined settings (i.e., the settings that determine whether a swiping "indicates an identification of ... organizing criteria"; Claim 1, lines 5 - 7). Specification, p. 37, lines 7 - 16 and lines 18 - 19. Dependent Claim 3 specifies that the detected swiping comprises "<u>repeatedly</u> swiping across a word, a phrase, or one or more contiguous characters ..." (emphasis added). Specification, p. 37, lines 9 - 12. (Dependent Claim 7 also refers to "swiping across one or more words, phrases, or characters ...".) Dependent Claim 4 specifies that the word/phrase/characters of Claim 3 is/are rendered "from a text document", while dependent Claim 5 specifies that the rendering is "from an e-mail message".

5.   Dependent Claim 6 is not under appeal, and will not be discussed further herein. Dependent Claim 8 specifies "swiping across a portion of one or more images ...". Specification, p. 26, line 16 - p. 27, line 19; p. 36, lines 3 - 8.

6.   Dependent Claim 10 specifies "... building one or more rules ... wherein the stored element [stored in response to a detected swiping that has a swiping manner consistent with previously-defined settings] is used as one of the organizing criteria in at least one of the rules". . Specification, p. 38, lines 8 - 11.

7.   Dependent Claim 11 specifies that the swiping comprises "moving a mouse device across the element at least twice" (emphasis added). Specification, p. 36, lines 17 - 18; p. 37, lines 9 - 14. Dependent Claim 12 specifies that the user "mov[es] a light pen across the element at least twice" (emphasis added). Specification, p. 36, line 18; p. 37, lines 9 - 14. Dependent Claim 13 specifies that the user "mov[es] his or her finger at least twice across the element" (emphasis added). Specification, p. 35, lines 15 - 17; p. 37, lines 9 - 14. Dependent Claim 14 specifies that the user "us[es] an audio mechanism by speaking commands ..." (Specification, p. 37, lines 1 - 3), and dependent Claim 15 specifies that the user "pass[es] his or her eyes repeatedly over the element" (emphasis added) (Specification, p. 36, line 19 - p. 37, line 1; p. 37, lines 9 - 14). Dependent Claim 16 specifies that the element "must be swiped across multiple times to indicate the identification" (emphasis added). Specification, p. 37, line 9 - 14.

8.   Dependent Claim 17 specifies "adding the swiped-across element to organizing criteria of

an index, thereby causing the index to become adaptive to the user swipings". Specification, p. 38, lines 4 - 5 and 8 - 10; see also p. 35, lines 6 - 15 and **Fig. 8**, reference numbers **810 - 840** and p. 36, lines 2 - 3.

9.   Independent Claim 18 includes means plus function terminology. Structure, material, or acts supporting this terminology are described in Appellants' specification, as will now be described.

10.   With regard to the "means for detecting" element of independent Claim 18, the text on p. 36, line 12 - p. 37, line 6 describes various user input monitors that might be used for detecting a swiping. For the "means for comparing" element, the text on p. 37, lines 7 - 18 describes obtaining configuration settings and using those settings (i.e., comparing them to the detected manner of swiping) to see if a swiping operation has been performed by the user. See also reference numbers **945** and **960** of **Fig. 9B**. The "means for storing" element is discussed at p. 37, lines 19 - 20, and the repository of criteria is illustrated at reference number **820** of **Fig. 8**. See also reference number **965** of **Fig. 9B**. The "means for enabling" element is discussed at p. 38, lines 8 - 11. See also p. 29, lines 13 - 15, discussing an example.

6)   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

11.   The **first ground of rejection** presented for review is a rejection of Claims 1 and 18 - 19 under 35 U.S.C. §112, second paragraph, as being indefinite.

12.   The **second ground of rejection** presented for review is a rejection of Claims 1 - 5, 7 - 8, and 10 - 19 under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,792,430 to Kenyon et al. (hereinafter, "Kenyon").

7)   ARGUMENT

7.1)   First Ground of Rejection

13.   Paragraph 3 of the Office Action dated February 13, 2006 (hereinafter, "the Office Action") states that Claims 1 and 18 - 19 are rejected under 35 U.S.C. §12, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention. These are all independent claims.

14.   In particular, the Office Action states that "comparing a manner in which the swiping was performed" on line 5 of Claim 1 and "what manner of swiping indicates an identification of dynamically-identified [user-defined organizing criteria]" on lines 6 - 7 of Claim 1 are not clearly understood. Similar terms are cited from Claims 18 and 19.

15.   Applicants respectfully submit that Claims 1 and 18 - 19 are <u>not</u> indefinite. Suppose, for example, that the "user has swiped across an element of a rendered representation of an electronic object" (Claim 1, lines 3 - 4) -- where this "element" might be (for example) a portion of a displayed photo image -- by passing the tip of his finger across the element 3 times within a 2-second time period. In this scenario, "a manner in which the [detected] swiping was performed" (Claim 1, line 5) comprises (i) swiping across the element 3 times; (ii) swiping across the element

using the tip of his finger; and (iii) all swiping occurring within a 2-second time period. Further

suppose that "previously-defined settings" (Claim 1, line 6) exist, where these settings specify that

a swiping must comprise (a) swiping across an element 2 or more times (b) within a time period

of less than 3 seconds. If this happens, then (according to Appellants' claim language, whereby

the detected swiping-across is "consistent with" the defined settings; Claim 1, line 9) the swiping

can be considered as "indicat[ing] an identification of dynamically-identified, user-defined

organizing criteria" (Claim 1, lines 6 - 7). Accordingly, in this example scenario, the comparing

step compares the "manner in which the swiping was performed" (for ease of reference

hereinafter, "the detected manner of swiping") to the "previously-defined settings that specify

what manner of swiping indicates ..." (for ease of reference hereinafter, "the specified manner of

swiping") -- in other words, the swiping-across 3 times within a 2-second time period with a

finger tip is compared to swiping-across 2 or more times within a time period of less than 3

seconds. In this example, the detected manner of swiping is consistent with the specified manner

of swiping, and thus the storing step will "stor[e] ... the swiped-across element in a repository of

criteria ..." (Claim 1, lines 8 - 11).

16.   Appellants respectfully submit that all limitations in independent Claims 1, 18, and 19 have

proper antecedent basis, and believe that the example described above in paragraph 15 will clarify

any confusion about the relationships among these limitations. Accordingly, Appellants

respectfully submit that independent Claims 1, 18, and 19 are not indefinite.

7.2)   Second Ground of Rejection

17.   Paragraph 5 of the Office Action states that Claims 1 - 5, 7 - 8, and 10 - 19 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,792,430 to Kenyon. Of these, the independent claims are 1, 18, and 19.

18.   Appellants respectfully submit that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out as to their Claims 1 - 5, 7 - 8, and 10 - 19. Section 706.02 of the MPEP, "Rejection on Prior Art", states in Section IV, "Distinction Between 35 U.S.C. 102 and 103", the requirements for establishing a *prima facie* case of anticipation under this statute, noting that "... for anticipation under 35 U.S.C. 102, the reference must teach <u>every aspect</u> of the claimed invention either explicitly or impliedly" (emphasis added). This requirement is also stated in MPEP §2131, "Anticipation -- Application of 35 U.S.C. 102(a), (b), and (e)", which states (in its final paragraph) "A claim is anticipated only if <u>each and every element</u> as set forth in the claim is found, either expressly or inherently described, in a single prior art reference", quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added. This final paragraph of MPEP §2131 also states "The elements <u>must be arranged</u> as required by the claim ...", quoting *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), emphasis added.

19.   Furthermore, Appellants are entitled to have <u>all words</u> of their claimed invention considered when determining patentability. See Section 2143.03 of the MPEP, "All Claim Limitations Must Be Taught or Suggested", referencing **In re Wilson**, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated "*All words* in a claim must be considered in judging the

patentability of that claim against the prior art." (emphasis added).

20.   The burden for rebutting a rejection under 35 U.S.C. 102 does not pass to Appellants until

a *prima facie* case of anticipation has been made out. See *In re Bass*, 177 USPQ 178, 186

(C.C.P.A. 1973), which held:

> From the evidence available to it, the initial burden of making out a prima
>
> facie case of prior invention is on the Patent Office. . . . When the Patent Office
>
> has made out a prima facie case of priority the burden would then shift to the
>
> applicant to rebut it.

Accordingly, Appellants respectfully submit that the burden has not passed. For the sake of

expediency, Appellants will, however, provide a rebuttal herein of the analysis provided in the

Office Action.

7.2.1) Rejection of Independent Claims 1, 18, and 19

21.   Appellants respectfully submit that Kenyon <u>fails to teach</u> all limitations of their

independent Claims 1, 18, and 19 -- and in particular, does <u>not</u> teach "each and every element" or

"all words" of these claims. The Office Action analysis therefore fails to make out a *prima facie*

case of anticipation, in violation of the above-quoted MPEP §706.02, §2131, and §2143.03, as

will now be demonstrated.

22.   Paragraph 5, lines 3 - 6 of the Office Action cite reference number **16** of Kenyon's **Fig. 1**

as well as col. 4, lines 24 - 28 and lines 25 - 37 as teaching the limitations in the first element of

Appellants' independent Claim 1 (i.e., "detecting, by a user input monitor, that a user has swiped across an element of a rendered representation of an electronic object"). Reference number **16** indicates that a user selects a URL. Col. 4, lines 24 - 28 specify that the user selects the URL "for example ... with the aid of a standard browser", and col. 4, lines 29 - 37 specify that "A check is made to see if the URL selected is in the current overlay ...", and various processing that occurs following this check. (An "overlay", as defined by Kenyon at col. 1, lines 46 - 49, is "a navigational model .. for linking together information objects on an existing information space", where a "digital information space" is exemplified by the World Wide Web, as stated in col. 3, lines 63 - 65.)

23.   Appellants respectfully submit that these citations from Kenyon cannot properly be equated to this first element of the claim language in independent Claim 1. It is well known, for example, that a URL is "selected", in "a standard browser", by double-clicking upon a hyperlink that represents the URL. Double-clicking is _different from_ Appellants' claim limitation of "swip[ing] across"; in fact, one can quickly and easily try "swiping across" a hyperlink using a pointing mouse. If the mouse button is _not_ depressed during the "swiping across", nothing happens. If the mouse button _is_ depressed during the "swiping across", an error indicator is generated when using Internet Explorer (where this error indicator comprises a graphic circle with a line extending diagonally from one side to the other).

24.   Accordingly, Appellants respectfully submit that _selecting a URL_ (as in Kenyon) is _distinct from_ their "swiping across" claim language specified in the first element (lines 3 - 4) of Claim 1.

Independent Claims 18 and 19 specify analogous limitations.

25.   With regard to the second element of Appellants' Claim 1 ("comparing a manner in which the swiping was performed ... to previously-defined settings ..."), the Office Action cites the same reference number **16** of Kenyon's **Fig. 1** and col. 4, lines 24 - 28 and lines 28 - 36, as well as reference number **18** of **Fig. 1**. (Office Action, paragraph 5, lines 6 - 12.) These citations cannot be equated to the limitations in Appellants' claim language, as will now be demonstrated.

26.   Reference number **16** and the text from col. 4 has been discussed above in paragraphs 22 - 23, where it has been shown that Kenyon's discussion of selecting a URL is distinct from Appellants' "swip[ing] across" claim language. Accordingly, processing of Kenyon's URL selection is distinct from "comparing a manner in which the swiping [across an element] was performed": Kenyon simply has no swiping, and therefore does not teach "comparing" how a swiping was performed.

27.   The Office Action cites reference number **18** and col. 4, lines 28 - 36 for "previously-defined settings" (Office Action, paragraph 5, lines 8 - 9), and cites this same text for "specify what manner of swiping indicates an identification of dynamically-identified, user-defined organizing criteria" (Office Action, paragraph 5, lines 9 - 12). Reference number **18** asks whether the selected URL is "in [the] current overlay". Appellants respectfully submit that there are no "previously-defined settings that specify what manner of swiping indicates ...", because Kenyon simply has no discussion of, nor any suggestion of, swiping across anything. Furthermore, even if

(*arguendo*) double-clicking on a hyperlink could be equated to swiping across an element, Kenyon fails to teach any <u>settings</u> associated with the double-clicking that would "specify <u>what manner of</u> swiping [double-clicking] indicates an <u>identification</u> of ... organizing criteria" (in contrast to Appellants' Claim 1, lines 6 - 7). That is, Kenyon does not teach, or suggest, that double-clicking in some particular "manner" (as previously defined in some "settings") could indicate "<u>by this manner of</u> double-clicking, I am identifying organizing criteria". Instead, Kenyon's user either double-clicks or does not, and there is no teaching, nor any suggestion, of <u>comparing a manner in which the double-clicking was performed</u> to previously-defined settings (in contrast to the limitations specified in lines 5 - 7 of Appellants' Claim 1).

28.   The Office Action specifies, in lines 11 - 12 of paragraph 5, that Kenyon's "checking if [user selected] URL is in current overlay" is analogous to Appellants' claim language, referring to reference number **18** of **Fig. 1**. That is, after the user has double-clicked upon a hyperlink for a URL, Kenyon is interested to know whether this URL was previously specified as being in the current overlay. (See also col. 4, lines 12 - 13, which specifies that "the <u>content of an overlay</u> preferably includes an <u>index of URLs in the overlay</u>"; emphasis added.) This type of checking, however, is <u>not the same</u> as the "comparing" which is specified in Appellants' claim language. The selected URL is either in the current overlay, or it is not, and Kenyon's checking at reference number **18** is limited to this determination. To use an analogy to Appellants' claim language, there is no comparing of <u>the manner in which</u> the URL was double-clicked to any <u>previously-defined settings that specify what manner of</u> double-clicking indicates an identification of organizing criteria.

29.   Accordingly, Appellants respectfully submit that <u>checking to see if a URL is in the current</u> <u>overlay</u> (as in Kenyon) is <u>distinct from</u> the "comparing" claim language specified in the second element (lines 5 - 7) of Claim 1. Independent Claims 18 and 19 specify analogous limitations.

30.   With regard to the third element of Appellants' Claim 1 ("storing ... the swiped-across element in a repository of criteria ..."), the Office Action cites reference numbers **26** and **30** of Kenyon's **Fig. 1**, as well as text in col. 4, lines 37 - 53 and lines 53 - 65 and col. 5, lines 14 - 37 (Office Action, p. 4, lines 2 - 10). These citations cannot be equated to the limitations in Appellants' claim language, as will now be demonstrated.

31.   Col. 4, lines 54 - 65 correspond to reference numbers **26** and **30** of Kenyon's **Fig. 1**, and state that "The user is permitted to add the URL into the current overlay in block **26**. When the user adds a digital information object to the overlay, an information node representing the digital information object is created in the overlay ... [after which] the user may input concepts, keywords, links to other documents ..., and annotations associated with the desired document as shown by block **30**.". Adding a URL which was selected through a double-clicking operation, as in Kenyon, to an overlay is distinct from "storing ... [a] <u>swiped-across element</u> in a repository of <u>criteria, from which the stored element can subsequently be selected for inclusion in a pattern</u> to be matched against electronic objects for <u>programmatically organizing</u> the electronic objects" (Claim 1, lines 8 - 11, emphasis added). Appellants find no teaching, nor any suggestion, in Kenyon of URLs being used in <u>patterns</u>, nor of using such patterns to <u>match against electronic</u> <u>objects</u> to <u>programmatically organize</u> those objects. In addition, inputting information that is

"relevant to" a desired document, as described by the text in col. 4, lines 54 - 65, does <u>not teach,</u> <u>or suggest</u>, storing a <u>swiped-across element</u> in a repository of criteria to be used for <u>programmatically organizing</u> electronic objects. (Refer, for example, to paragraphs 22 - 23, above, which demonstrate that Kenyon has no teaching or suggestion of "swiped-across elements".)

32.   Referring now to the cited text in col. 5, lines 14 - 37, this text discusses how user-selectable "overlay links" may be indicated graphically, and states that the user may control how this graphic "signaling" (i.e., indicating) may be done (col. 5, lines 14 - 21). Using examples described therein, the user might specify that a different font or a different point size indicates an overlay-defined link. (However, none of these examples teaches, or suggests, settings that pertain to <u>swiping across</u> an element, in contrast to Appellants' claim language.) The text in col. 5, lines 22 - 37 further discusses what happens when a user selects one of these overlay-defined links. In particular, selecting (e.g., by double-clicking) one of the links causes a pop-up menu to be displayed, where the pop-up menu "includes the titles of all the documents that have been linked to the concept described by the highlighted [i.e., selected] keyword" (col. 5, lines 22 - 25). Using an example from Kenyon, if the user double-clicks on a highlighted word "poodle" or "dalmatian", the pop-up menu may contain a list of documents that pertain to dogs. Col. 5, lines 1 - 13.

33.   The Office Action cites this text from col. 5, lines 14 - 37 with regard to the third element of Claim 1, and states (in the final three lines of paragraph 5) "selected URL criteria is defined and

saved for next URL criteria request". However, Appellants respectfully submit that (in contrast to their claim language) a "URL criteria request" is <u>not</u> a pattern for matching against electronic objects, and is not usable for <u>organizing</u> any such objects.

34.   Accordingly, Appellants respectfully submit that <u>adding a URL and other relevant information to an overlay</u> (as discussed in Kenyon's col. 4, lines 37 - 65) and/or <u>showing a pop-up menu in response to double-clicking on a keyword</u> (as discussed in Kenyon's col. 5, lines 14 - 37) is <u>distinct from</u> the "storing" claim language specified in the third element (lines 8 - 11) of Claim 1. Independent Claims 18 and 19 specify analogous limitations.

35.   Furthermore, to suggest that Kenyon's references to selecting URLs, including URLs and other relevant information in overlays, and displaying pop-up menus in response to keyword selection teaches the <u>precise claim language</u> of Appellants' independent claims violates the holding of the Federal Circuit in ***Motorola, Inc. v. Interdigital Technology Corp.***, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997), which stated

> For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim <u>with sufficient clarity to prove its existence</u> in the prior art. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990) ("[T]he [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge <u>does not grant a license to read into the prior art reference teachings that are not there</u>. (emphasis added)

36.   In view of paragraphs 18 - 35 herein, Appellants respectfully submit that the Office Action

fails to cite a reference that teaches <u>each and every element</u> of Appellants' independent Claims 1, 18, and 19, and fails to cite a reference that teaches <u>all words</u> of the claim language of these claims, in violation of the above-quoted MPEP §706.02, §2131, and §2143.03. Furthermore, Kenyon fails to disclose each and every element of Appellants' claim language <u>with sufficient clarify to prove its existence in the prior art</u>, in violation of the holding of ***Motorola, Inc.*** As a result, the Office Action fails to make out a *prima facie* case of anticipation as to independent Claims 1, 18, and 19. Without more, these claims are deemed patentable. See ***In re Oetiker***, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

> If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

7.2.2) Rejection of Dependent Claims 2, 7 - 8, 10, and 17

37.   Dependent Claims 2, 7 - 8, 10, and 17 stand or fall with independent Claim 1, from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of independent Claim 1.

7.2.3) Rejection of Dependent Claim 3

38.   Claim 3 specifies that "the detected swiping further comprises <u>repeatedly swiping across</u> a word, a phrase, or one or more contiguous characters ..." (emphasis added). With regard to this claim language, page 4, lines 13 - 16 of the Office Action cite col. 5, lines 14 - 37. This text from Kenyon has been discussed above in paragraphs 32 - 34. Nowhere in this cited text is there any mention of "<u>repeatedly</u> swiping across a word, phrase, or one or more contiguous characters" (in

contrast to Claim 3, line 2; emphasis added). Instead, the cited text merely discusses selecting highlighted keywords, and as noted in paragraphs 22 - 23 above, selecting a URL (or a highlighted keyword) "with the aid of a standard browser" is conventionally done by double-clicking on a graphical representation of a hyperlink, and double-clicking is <u>different from</u> Appellants' "<u>swiping across</u> an element" claim language. Because Kenyon fails to teach or suggest "swiping across", as demonstrated herein with reference to Appellants' independent claims, it follows that Kenyon fails to teach or suggest "<u>repeatedly</u> swiping across". Thus, Kenyon fails to teach <u>each and every element</u> of Appellants' dependent Claim 3, and fails to teach <u>all words</u> of the claim language of this claim.

39.   Because the cited text fails to teach <u>each and every element</u> of Appellants' dependent Claim 3 <u>with sufficient clarify to prove its existence</u> in the prior art, and fails to teach <u>all words</u> of this claim language, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation as to this dependent claim, and without more, this claim is deemed patentable. (This dependent claim is also deemed patentable by virtue of the allowability of independent Claim 1, from which it depends.)

7.2.4) Rejection of Dependent Claims 4 - 5

40.   Dependent Claims 4 - 5 stand or fall with dependent Claim 3, from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of Claim 3, the patentability of which is discussed above in paragraphs 38 - 39.

7.2.5) Rejection of Dependent Claims 11 - 13

41.   With regard to dependent Claims 11 - 13, the Office Action cites Kenyon's **Fig. 1** and col. 4, lines 54 - 65. Office Action, p. 5, line 12 - p. 6, line 3. Each of these dependent claims specifies a limitation of "moving ... <u>at least twice across</u> the element" to further limit the "detecting that the user swiped across an element" limitation from independent Claim 1. In Claim 11, the "at least twice" pertains to moving a mouse device, whereas in Claims 12 and 13, the "at least twice" pertains to moving a light pen device and moving a finger of the user, respectively.

42.   Appellants respectfully submit that Kenyon's **Fig. 1** has no teaching, nor any suggestion, of "moving [anything] at least twice across" an element of a rendered representation. Appellants note that the cited text discusses adding a URL to the current overlay (col. 4, lines 55 - 56), and it may be presumed that the user first <u>selected</u> the URL. However, whereas selecting a URL may require double-clicking upon a hyperlink, this does not involve <u>moving anything across</u> the hyperlink. Accordingly, Appellants fail to see any relevance of the cited text in col. 4, lines 54 - 65 to the claim language of dependent Claims 11 - 13, as nothing is mentioned therein of moving anything "at least twice" across an element.

43.   Because the cited text fails to teach <u>each and every element</u> of Appellants' dependent Claims 11 - 13, and fails to teach <u>all words</u> of the claim language of these claims, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation as to these dependent claims, and without more, the claims are deemed patentable. (These dependent claims are also deemed patentable by virtue of the allowability of independent Claim 1, from

which they depend.)

7.2.6) Rejection of Dependent Claim 14

44.   Claim 14 specifies a limitation of "speaking commands in the manner specified in the previously-defined settings". With regard to this claim language, the Office Action cites Kenyon's **Fig. 1** and page 3, sections **[0041] - [0043]**. Office Action, p. 6, lines 4 - 6. This is apparently a typographical error, referring to paragraphs of Smith et al. (U. S. Patent Publication 2003/0105765; hereinafter, "Smith"), which was cited in the Office Action dated August 10, 2005.

45.   Smith has no "settings that specify <u>what manner of swiping</u> indicates an <u>identification</u> of ... organizing <u>criteria</u>" (Claim 1, lines 6 - 7, emphasis added); and, at any rate, Smith has not been cited in the present §102 rejection. Appellants respectfully submit that Kenyon also fails to teach or suggest "speaking commands in the manner specified in the previously-defined settings".

46.   Because the Office Action fails to cite a reference that teaches <u>each and every element</u> of Appellants' dependent Claim 14, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation as to this dependent claim, and without more, Claim 14 is deemed patentable. (Claim 14 is also deemed patentable by virtue of the allowability of independent Claim 1, from which it depends.)

7.2.7) Rejection of Dependent Claims 15 - 16

47.   Dependent Claim 15 specifies a limitation of "passing his or her eyes <u>repeatedly over</u> the element" (emphasis added), and dependent Claim 16 specifies a limitation of "the settings specify that the element of the rendered representation must be <u>swiped across multiple times</u> to indicate the identification" (emphasis added). For both claims, the Office Action cites col. 4, lines 12 - 44 of Kenyon. Office Action, p. 6, lines 7 -11.

48.   In contrast to the limitations of Claim 15, Appellants respectfully submit that Kenyon has no teaching, nor any suggestion, of a user "passing his or her eyes <u>repeatedly over</u> the element" (emphasis added) -- or, for that matter, of a user doing <u>anything</u> with his or her eyes.

49.   With regard to Claim 16, the cited text has no discussion, nor any suggestion, of <u>settings</u> that specify <u>anything about "swip[ing] across</u>" an element <u>multiple times</u>. Instead, the cited text merely refers to "selecting" URLs, and without more, this is deemed to be a conventional URL selection technique (as discussed above in paragraphs 22 - 23), which does not involve <u>swiping across</u> anything <u>multiple times</u>.

50.   Because the Office Action fails to cite a reference that teaches <u>each and every element</u> of Appellants' dependent Claims 15 - 16, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation as to these dependent claims, and without more, Claims 15 - 16 are deemed patentable. (Claims 15 - 16 are also deemed patentable by virtue of the allowability of independent Claim 1, from which they depend.)

8) CONCLUSION

For the reasons set out above, Appellants respectfully contend that each appealed claim is

patentable, and respectfully request that the Examiner's Final Rejection of appealed Claims 1 - 5,

7 - 8, and 10 - 19 should be reversed.

Respectfully submitted,

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CLAIMS AS CURRENTLY PRESENTED:

1 Claim 1: A computer-implemented method for indicating criteria for organizing electronic

2 objects, comprising steps of:

3   detecting, by a user input monitor, that a user has swiped across an element of a rendered

4 representation of an electronic object;

5   comparing a manner in which the swiping was performed, responsive to the detecting, to

6 previously-defined settings that specify what manner of swiping indicates an identification of

7 dynamically-identified, user-defined organizing criteria; and

8   storing, if the comparing step determines that the manner in which the swiping was

9 performed is consistent with the specified settings, the swiped-across element in a repository of

10 criteria, from which the stored element can subsequently be selected for inclusion in a pattern to

11 be matched against electronic objects for programmatically organizing the electronic objects.

1 Claim 2: The method according to Claim 1, further comprising the step of enabling the user to

2 configure the defined settings.

1 Claim 3: The method according to Claim 1, wherein the detected swiping further comprises

2 repeatedly swiping across a word, a phrase, or one or more contiguous characters in the rendered

3 representation, and wherein the storing step stores the swiped-across word, phrase, or one or

4 more contiguous characters as the stored element.

Claim 4: The method according to Claim 3, wherein the word, the phrase, or the characters is/are rendered from a text document.

Claim 5: The method according to Claim 3, wherein the word, the phrase, or the characters is/are rendered from an e-mail message.

Claim 6: The method according to Claim 1, wherein:

the detected swiping further comprises swiping across a portion of an image in the rendered representation; and

the storing step stores the swiped-across image portion as the element; and further comprising the steps of:

including the stored image portion in a particular pattern to be matched against electronic objects; and

using the particular pattern for programmatically organizing the electronic objects, further comprising the steps of:

evaluating content of each of the electronic objects with respect to the particular pattern; and

including each of the compared objects in a category to which the particular pattern corresponds if the evaluating step determines that the content matches the particular pattern, including the image portion included therein.

Claim 7: The method according to Claim 1, wherein the detected swiping further comprises

2 swiping across one or more words, phrases, or characters in the rendered representation as the

3 element.

1 Claim 8: The method according to Claim 1, wherein the detected swiping further comprises

2 swiping across a portion of one or more images in the rendered representation as the element.

Claim 9 (canceled)

1 Claim 10: The method according to Claim 1, further comprising the step of building one or more

2 rules, each rule specifying a pattern that comprises at least one organizing criteria to be matched

3 against electronic objects for programmatically organizing the electronic objects, wherein the

4 stored element is used as one of the organizing criteria in at least one of the rules.

1 Claim 11: The method according to Claim 1, wherein the detecting step further comprises

2 detecting that the user swiped across the element by moving a mouse device across the element at

3 least twice.

1 Claim 12: The method according to Claim 1, wherein the detecting step further comprises

2 detecting that the user swiped across the element by moving a light pen device across the element

3 at least twice.

1 Claim 13: The method according to Claim 1, wherein the detecting step further comprises

2   detecting that the user swiped across the element by moving his or her finger at least twice across

3   the element, wherein the element is rendered on a plasma panel device.

1   Claim 14: The method according to Claim 1, wherein the detecting step further comprises

2   detecting that the user swiped across the element using an audio mechanism by speaking

3   commands in the manner specified in the previously-defined settings.

1   Claim 15: The method according to Claim 1, wherein the detecting step further comprises

2   detecting that the user swiped across the element using a video mechanism by passing his or her

3   eyes repeatedly over the element.

1   Claim 16: The method according to Claim 1, wherein the settings specify that the element of the

2   rendered representation must be swiped across multiple times to indicate the identification.

1   Claim 17: The method according to Claim 1, wherein the storing step further comprises adding

2   the swiped-across element to organizing criteria of an index, thereby causing the index to become

3   adaptive to the user swipings.

1   Claim 18: A system for indicating criteria for organizing electronic objects, comprising:

2   a processor;

3   means for detecting, by a user input monitor of the processor, that a user has swiped

4   across an element of a rendered representation of an electronic object;

5   means for comparing, by the processor, a manner in which the swiping was performed,

6   responsive to the means for detecting, to previously-defined settings that specify what manner of

7   swiping indicates an identification of dynamically-identified, user-defined organizing criteria;

8   means for storing, if the means for comparing determines that the manner in which the

9   swiping was performed is consistent with the specified settings, the swiped element in a repository

10   of criteria usable by the processor for programmatically organizing electronic objects; and

11   means for enabling the stored element to be subsequently selected as an organizing

12   criterion for use in a rule, wherein the rule can subsequently be used for programmatically

13   organizing the electronic objects.

1   Claim 19: A computer program product for indicating criteria for organizing electronic objects,

2   the computer program product embodied on one or more computer-readable media and

3   comprising code that, when executed on a computer, causes the computer to:

4   detect, by a user input monitor, that a user has swiped across an element of a rendered

5   representation of an electronic object;

6   compare a manner in which the swiping was performed, responsive to the detection, to

7   previously-defined settings that specify what manner of swiping indicates an identification of

8   dynamically-identified, user-defined organizing criteria;

9   store, if the comparison determines that the manner in which the swiping was performed

10   is consistent with the specified settings, the swiped element in a repository of criteria usable for

11   programmatically organizing electronic objects; and

12   enable the stored element to be used as an organizing criterion in a rule, wherein the rule

13   can subsequently be used for programmatically organizing the electronic objects.

Claim 20 (canceled)

EVIDENCE APPENDIX

Appellants, the Appellants' legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.

RELATED PROCEEDINGS APPENDIX

No related proceedings are personally known to Appellants, the Appellants' legal representative, or the assignee.